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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BOMAR, THOMAS S

ART UNIT PAPER NUMBER

3672

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/070,990

Applicant(s)

MCGARIAN, BRUCE

Examiner

Shane Bomar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: T. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because the second use of reference sign B is missing a connecting line in Fig. 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: the specification does not have the appropriate section headings as seen below.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

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- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said profile" and "said profile portion" in the last four lines of the claim. There is insufficient antecedent basis for this limitation in the claim. It is noted that the following recitations were previously used in the claim: "a first portion of said latch

profile” and “a further profile portion”. It is unclear as to which profile or portion the aforementioned limitations are directed to. Also, the recitation of “radical” in line 9 should most likely be --radial--.

Claims 2-4 are also considered indefinite since they depend from claim 1.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 5,785,133 to Murray et al in view of US patent 5,425,419 to Sieber.

Regarding claim 1, as best understood, Murray et al teach in Figs. 11-14 a downhole system for locating and fixing equipment at required depth and orientation within a wellbore (see col. 2, lines 47-52). The system comprises a portion of wellbore casing 52 having an inner surface in which a latch profile 144 is defined. The downhole apparatus comprises a latch sub 80 for locating equipment secured thereto at a required depth and orientation (see col. 2, lines 53-55). The latch sub 80 comprises a body 156 and a latching member 82 mounted on the body so as to be movable between a retracted position and an extended position, the latching member 82 projecting a greater radial distance from the body when in the extended position than when retracted (see Figs. 11 and 12). The latching member 82 is adapted to project into the latch profile 144 when extended during use and wherein a first portion of the latch profile is adapted to

be engaged by the latching member in such a way that, when pressed against the profile portion, the member 82 tends to slide along a wellbore casing edge defining the profile portion so as to locate the member 82 in abutment with a further profile portion 132 and thereby prevent further movement of the latch sub 80 in the direction of pressing (see col. 11, lines 31-38). The latching member 82 is further adapted to engage a portion 135 of the profile 132 in such a way that, when pressed against the profile portion 132, the member 82 is moved towards the retracted position so as to permit movement of the apparatus past the profile 132 (see col. 11, lines 39-54).

Murray et al do not teach that an anchor packer is attached to the latch sub. Sieber teaches an anchor packer 14M attached to a whipstock sub 15 (see col. 22, lines 45-52 and col. 16, lines 9-20). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide Murray et al's latch sub with an anchor packer as taught by Sieber. One would have been motivated to make this combination so that the whipstock will be held in the desired orientation in the well bore (see col. 13, lines 50-52 of Sieber).

Regarding claim 2, the combination as applied to claim 1 above, teaches that the latch profile 144 is of a V-shape (see 143 of Fig. 14 of Murray et al).

Regarding claim 3, the combination as applied to claim 1 or 2 above, teaches that the anchor packer is a weight set anchor packer (see col. 3, lines 17-20 and col. 13, lines 37-45 of Sieber).

Regarding claim 4, the combination as applied to claim 1 above, teach a method of positioning downhole equipment within a wellbore. The method comprises the steps of providing a latch profile in the wall of the well bore or casing, determining the position and orientation of the latch profile, making up a string comprising an anchor packer and equipment to

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be positioned within the well, the equipment being fixed relative to a latch member for locating in the latch profile and the equipment being positioned and oriented relative to the latch member in view of the determination so as to ensure a desired position and orientation of the equipment, running the string downhole, locating the latch member in the profile, sliding the latch member along an edge of the latch profile until a portion of the latch profile stops the sliding movement, and setting the anchor packer (see col. 2, lines 47-64 and col. 4, lines 10-24 of Murray et al; col. 16, lines 9-20 of Sieber).

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Braddick, Braddick et al, Buyaert, Comeau et al, Hayes et al, Hughes et al, Jordan et al, Nitis et al, Ohmer et al, and Parks et al teach different types of whipstock setting and orientation apparatuses.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 703-305-4849. The examiner can normally be reached on Monday - Thursday from 7:00am to 4:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 703-308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4198.



David J. Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

tsb



April 3, 2003